



**MAIL STOP AF**  
**PATENT**  
Customer No. 22,852  
Attorney Docket No. 5755.0864-01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
**Rainer MÜLLER et al.** ) Group Art Unit: 1615  
)  
Application No.: 10/798,442 ) Examiner: Venkat, Jyothsna A.  
)  
Filed: March 12, 2004 ) Confirmation No.: 5278  
)  
For: CLEANSING COSMETIC )  
COMPOSITIONS AND USE )

**MAIL STOP: AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the Final Office Action mailed March 2, 2006, the time period for response to which has been extended to August 2, 2006, by the Petition for Two-Month Extension of Time and fee payment filed concurrently herewith, Applicants respectfully request panel review of this application. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31 and appeal fee payment. No amendments are filed with this Request.

The arguments raised below are not a comprehensive set of Applicants' traversal of the rejections of record in the Final Office Action; rather, they represent a summary of Applicants' arguments. Applicants reserve the right to raise additional arguments on appeal, including arguments that were not presented in this paper due to the five page limit.

Claims 19-23, and 31-40 are pending. Claims 19-23 and 31-40 stand rejected under 35 U.S.C. § 112, first paragraph because, according to the Examiner, these claims contain new matter. Specifically, the Examiner maintains that the as-filed specification, which recites “more or less thickened liquids,” does not support the claim language, specifically the term “liquid detergent.” This argument is based on the Examiner’s assertion that generic liquids are less viscous than thickened liquids.

Applicants maintain that the distinction between “liquids” and “more or less thickened liquids” proffered by the Examiner does not give rise to a rejection under 35 U.S.C §112, first paragraph. For example, in the Advisory Action, the Examiner states that “[l]iquid is easily flowing where as thickened liquid are not easily flowable like liquids. [T]herefore ‘liquid’ is new matter.” Applicants note, however, that as admitted by the Examiner, the as-filed specification discloses detergents that are “more or less thickened liquids.” Thus, there can be no argument that the specification discloses “liquid” detergents. Moreover, based on this disclosure of “more or less thickened liquids,” one of ordinary skill in the art would necessarily conclude that Applicants had possession of the claimed liquid detergent and cosmetic hair composition: a thickened liquid is nonetheless a liquid. Thus, Applicants submit that the § 112 rejection of claims 19-23 and 31-40 is improper, and should be withdrawn.

Claims 19-23 and 31-38 stand rejected under §102(b) as anticipated by U.S. Patent No. 5,013,763 to Tubesing (“*Tubesing*”). Applicants maintain that the Examiner has not established that *Tubesing* teaches all of the limitations of claims 19-23 and 31-38. For example, the Examiner has not established that *Tubesing* teaches a

liquid detergent and conditioning cosmetic composition comprising, *inter alia*, a washing base.

According to the Examiner, the claimed washing base is merely a surfactant. Thus, the Examiner maintains that because *Tubesing* discloses compositions that include surfactants, e.g., Ceteareth-20, it contains the claimed "washing base." Applicants disagree.

As highlighted in the Response filed June 2, 2006, *Tubesing* discloses a **wash resistant skin preparation**, whereas the present claims recite a liquid detergent and conditioning cosmetic **hair** composition designed to be **removed by washing**. Thus, the compositions of *Tubesing*, despite containing a surfactant, are different from the claimed invention in two respects. First, *Tubesing's* compositions are skin preparations, whereas the claimed invention is a hair composition. Second because the compositions of *Tubesing* exhibit **wash-resistance** (the opposite function of the claimed washing base), they cannot be said to contain the claimed washing base. In other words, even though *Tubesing* may contain surfactants, such surfactants clearly are *not* equivalent to the claimed washing base, as they do not perform the functions of a washing base, e.g., to **decrease** the wash resistance of composition. Thus, the §102(b) rejection is improper, and should be withdrawn.

Finally, claims 19-23, and 31-40 stand rejected as being unpatentable over *Tubesing* in view of U.S. Patent No. 6,143,286 to Bhambani ("*Bhambani*"). In the rejection, the Examiner admits that *Tubesing* fails to disclose a composition comprising the amount of washing base recited in claims 39 and 40. Noting that *Bhambani* teaches a hair treatment composition that contains similar components (e.g., surfactants and

esters) as the skin treatment composition of *Tubesing*, and utilizes the claimed amount of surfactant, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Tubesing* to use the quantity of surfactant recited in *Bhambani* for the purpose of arriving at a cleansing composition. Applicants respectfully disagree, and submit that the Examiner has not established that there is any teaching or suggestion in the applied prior art that would have motivated one of ordinary skill to modify *Tubesing* further to the teachings of *Bhambani*, much less with the requisite reasonable expectation of success.

*Tubesing* discloses a **skin preparation** that is **wash-resistant**. *Bhambani*, on the other hand, teaches a **shampoo** composition containing various **cleansing surfactants**. One of ordinary skill would understand that one of the primary purposes of a cleansing surfactant in a hair care composition is to bind impurities such that they may be **washed away**. Thus, Applicants are at a loss as to *why* one of ordinary skill in the art would modify *Tubesing* per the teaching of *Bhambani* in such a way as to make the composition of *Tubesing* **less** wash-resistant. Such a modification goes against the express teachings of *Tubesing*.

Moreover, nothing in the applied art teaches that the surfactants utilized in *Bhambani* are equivalent to those used in *Tubesing*, or that the relative amounts of surfactant disclosed by *Bhambani* would be suitable for the composition disclosed by *Tubesing*. Indeed, contrary to the Examiner's position, given that the skin preparation of *Tubesing* is designed to be wash resistant, whereas cleansing surfactants used in shampoos (such as those in *Bhambani*) are designed to be rinsed out of hair, Applicants submit that one of ordinary skill in the art would not have been motivated to

combine *Tubesing* with *Bhambani* in the manner asserted, much less with a reasonable expectation of success.

Further, given the teachings of *Tubesing* and *Bhambani*, Applicants submit that one of ordinary skill in the art would expect that the combination proposed by the Examiner would be detrimental to the wash-resistance of the skin-preparation of *Bhambani*. Thus, if anything, one of ordinary skill would have been led away from the asserted combination in view of the disclosure of the applied references.

For at least the foregoing reasons and those presented in Applicants' prior responses, Applicants submit that the rejections of record are in error, and respectfully request reconsideration and withdrawal of all of the pending rejections.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: 

Mark D. Sweet  
Reg. No. 41,469

Dated: August 2, 2006